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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Orion Electric Co., Ltd.
v.
Orion Electric Co., Ltd.

Opposition No. 91121807
to Application No. 75643483
filed on February 18, 1999

Kaushal R. Odedra of Wenderoth, Lind and Ponack for Orion
Electric Co. Ltd., opposer.

John C. Gorman of Gorman & Miller for Orion Electric Co.
Ltd., applicant.

Before Simms, Walters and Rogers, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Orion Electric Co., Ltd. (opposer), a Japanese company,
filed its opposition to the application of Orion Electric
Co., Ltd. (applicant), an unrelated Korean company, to

register the mark ORION for "display monitors, moniputers and related accessories," in International Class 9.¹

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods so resembles opposer's previously used and registered mark ORION for "video tape recorders and players, and television sets"² as to be likely to cause confusion, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). In particular, opposer alleges that the marks are identical; that applicant's goods, display monitors and moniputers, and opposer's television sets are all capable of displaying images from computers and television programming, as well as Internet content; and that the goods are sold to the same purchasers through the same channels of trade.

As a second ground for opposition, opposer alleges that the opposed application is based solely on use in commerce, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a); that, at the time of filing, applicant was not using its mark on all of the identified goods; and that, therefore, the application is void as filed.

¹ Application Serial No. 75643483, filed February 18, 1999, based upon use of the mark in commerce, alleging dates of first use and first use in commerce as of October 1998.

² Registration No. 1,727,083, issued October 27, 1992, in International Class 9. [Sections 8 and 15 affidavits accepted and acknowledged, respectively. Renewed for a period of ten years from October 27, 2002.]

Applicant, in its answer, denied the salient allegations of the claim, although applicant admitted that opposer is the holder of its claimed registration, and that the parties' marks are "identical in English spelling." Additionally, applicant stated its belief that "television sets are not used to display images from computers"; and that "television sets typically are not used to display images from the worldwide web." Applicant has asserted as affirmative defenses unclean hands, laches, waiver, acquiescence and/or estoppel³; and that applicant is the owner of U.S. Trademark Registration No. 1,114,405 and "the present application covers usage that is consistent with or a logical expansion of applicant's existing mark."⁴

The Record

The record consists of the pleadings; the file of the involved application; a certified status and title copy of Registration No. 1,727,083; various specified responses of applicant to opposer's interrogatories and requests for admissions, and of opposer to applicant's interrogatories and requests for admissions, copies of third-party

³ These defenses were not tried by the parties or argued in their briefs. Therefore, these defenses are considered waived and require no discussion.

⁴ To the extent that this is an assertion of a "Morehouse" defense, the facts and type of proceeding herein are not appropriate for such a defense. *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 U.S.P.Q. 715 (C.C.P.A. 1969). Therefore, any such "Morehouse" defense fails. We have considered the statement in applicant's pleading as merely an affirmative statement.

registrations, copies of print advertisements and magazines, results of searches of the Internet, and the result of a search of the State of California Department of Corporations via the Internet, all made of record by opposer's and applicant's notices of reliance⁵; the testimony depositions by opposer, with accompanying exhibits, of Neil Sinclair, director of marketing of opposer's affiliate, of Kay Tate, customer service representative and receptionist of opposer's affiliate, and of Rena Meritt, national service manager of opposer's affiliate; and the testimony depositions by applicant, with accompanying exhibits, of I.S. Kim, applicant's general manager, and of Duk Jung ("John") Kim, president of applicant's affiliate.⁶ Both parties filed briefs on the case and an oral hearing was held, although only opposer appeared at the oral hearing.

Preliminary Matters

First, we consider the following claims asserted by opposer in its amended notice of opposition:

16. On information recently discovered from Applicant's recent discovery responses, as of the date Applicant filed its U.S. Trademark Application Serial No. 75/463,483 based solely

⁵ Information downloaded from the Internet may not be made of record by notice of reliance. However, because there were no objections to this evidence, we have treated it as stipulated into the record. We add that our decision would remain the same even if this evidence had not been considered.

⁶ Applicant submitted only partial transcripts of the depositions of its witnesses. However, opposer submitted copies of applicant's witnesses' transcripts in their entirety, as is required, "to avoid delays." [Opposer's brief, p. 8.] Thus, we have considered this testimony.

on use in commerce under Section 1(a) of the trademark act, Applicant was not using the ORION mark on all of the goods identified in the application, thus making the application Serial No. 75/643,483 void as filed.

17. On information recently discovered from Applicant's recent discovery responses, as of the date Applicant filed its U.S. Trademark Application Serial No. 75/463,483 based solely on use in commerce under Section 1(a) of the trademark act, Applicant was not using the ORION mark on the goods "moniputers and related accessories" identified in the application, thus making the application Serial No. 75/643,483 void as filed.

Applicant answered each of these paragraphs with a denial.

In its brief, while not using the term "fraud" in its narrative, opposer recited the fraud "test" for listing in a use-based application goods upon which the mark has not been used, i.e., "applicant knew or should have known, applicant was not using the mark ... on all of the goods identified ..." (Brief, p. 27), and opposer cited only cases involving fraud in support of its position that the application is void. In its brief, applicant addressed opposer's claim in a section with the following heading:

Applicant did not commit fraud in or with respect to its application. Opposer has failed to meet the heavy burden of proof necessary to show fraud in applicant's application.

The cases cited by applicant in its brief also pertain to fraud and applicant argued against a finding of fraud.

In view of these facts, we find that, the parties have tried the issue of fraud. Fed. R. Civ. P. 15(b). Not only did opposer question applicant's witnesses about its use of

the mark on the goods listed in the identification, but, applicant, in its brief, essentially concedes that fraud is an issue in this case.

We turn next to address, preliminarily, the identification of goods. The identification of goods in the application as originally filed was as follows:

display monitors and parts and accessories thereof; vacuum tubes, electronic tubes, fluorescent discharge tubes, deflection yokes, rectifier tubes, infrared lamps for laboratory use, electronic signboards, diodes, semi-conductor devices, integrated circuits, video phones, telephones, electroluminescent displays, cathodoluminescent field emitter displays, light emitting diodes, ionized gas discharge plasma displays, vacuum fluorescent displays, flyback transformers, electric capacitors, and oscillographs.

During examination, the identification of goods was amended to read as follows, and this is the identification of goods for which the mark was published on November 12, 2000:

Display monitors, moniputers, and related accessories.

The notice of opposition was filed on January 11, 2001, and the Board mailed notice and trial dates to the parties on January 26, 2001. Applicant filed its answer on March 12, 2001. Subsequently, on April 21, 2001, the Examining Attorney entered, by Examiner's Amendment, a further amendment to the identification of goods to read as follows:

Display monitors, moniputers, and computer peripherals.

Clearly, this was an improper action because the Examining Attorney no longer has jurisdiction over an application once an opposition has been filed. Trademark Rule 2.133(a), 15 U.S.C. § 2.133(a). See, *Trademark Trial and Appeal Board Manual of Procedure (TBMP)* (2nd ed. June 2003), §§ 514, 514.01 and 514.03. If an amendment is filed in an application that is the subject of an opposition, the Board has jurisdiction over the application and will determine the propriety of the amendment. Once an opposition has commenced, the application that is the subject of the opposition may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board. (*id.*) Generally, such motion must be filed prior to trial.

We consider the Examiner's Amendment to be void because, at the time of the Examiner's Amendment, the Examining Attorney did not have jurisdiction over the application and an amendment to the identification of goods is an amendment of substance. Applicant did not file a motion with the Board to amend its identification of goods; however, both parties discussed the amendment to the goods, distinguishing them from the goods as published, in their briefs. Therefore, we have deemed the Examiner's Amendment to be applicant's motion to amend its identification of

goods without consent and we will consider it within the context of this final decision.

Finally, we consider applicant's contention in its brief that opposer's evidence of actual confusion, in the form of e-mails and telephone calls reported by opposer's testimony witnesses, constitutes hearsay. The case law clearly establishes that statements by opposer's testimony witnesses regarding third-party communications to them, in the form of e-mail or telephone calls, are evidence that the communications were made to them. The statements are not offered for the truth thereof. *See, Corporate Fitness Programs, Inc. v. Weider Health and Fitness, Inc.*, 2 USPQ2d 1682 (TTAB 1987). Therefore, applicant's objections are overruled and these statements have been considered.

Factual Findings

The record establishes all of the following facts in this case.

Opposer is a Japanese company that conducts all marketing and sales in the United States exclusively through Orion America, Inc. dba Orion Sales, Inc. (encompassed by the term "opposer"). Opposer manufactures televisions (TVs), video cassette recorders (VCRs) and combination TV/VCRs identified by the trademark ORION, which appears on the products, packaging and accompanying instruction manuals. Opposer began selling its ORION TVs and VCRs in

the U.S. in 1993. Opposer sells the vast majority of its products in the U.S. through Wal-Mart, a well known mass merchandiser; although it sells some products via the Internet at its web address, www.orionsalesinc.com. Opposer has VCRs and TVs that retail for approximately \$60 and \$80, respectively, and its most expensive ORION product is its combination TV/VCR/DVD, which retails for approximately \$300. Wal-Mart promotes opposer's ORION products through inclusion in its promotional mailings and TV advertising, and, within the stores, with stand-alone displays and point of purchase display cards. Opposer does not manufacture or sell computer display monitors.

Applicant is a Korean company that manufactures cathode ray tubes and computer display monitors. Applicant admits that, regardless of its identification of goods, it has used the ORION mark in the U.S. only on computer display monitors. When asked about the additional goods listed on applicant's trademark application, Mr. I.S. Kim, applicant's general manager, stated the following⁷:

Answer: Well, these other items that were listed, we were in consideration of the possibility of using these products for registration purposes. But our main concern and major product is the computer monitor. And there are many components and the brand being shown outside is not that important.

⁷ Other than argument in applicant's brief, there is no other "reason" given for inclusion of the goods other than computer monitors in the identification of goods.

Question: To rephrase what you just stated. Your main product on this list is display monitors, and that's what you were and have been using with the Orion brand. The other items listed, including video phones and telephones, have never been used or sold or promoted in the United States with the Orion brand; is that correct?

Answer: Yes. Also, we have no plans to manufacture them either.

Applicant sells its computer display monitors in the U.S. through its affiliate, Orion Display, Inc. (encompassed by the term "applicant"). Applicant has sold its ORION display monitors in the U.S. since 1998. Applicant sells its ORION display monitors to distributors and dealers, who resell them to consumers. Applicant also sells both ORION and unbranded display monitors to value added resellers (VARs), who bundle them with computer hardware and software for sale primarily to corporations and schools. While Mr. John Kim, president of applicant's U.S. affiliate, indicated that applicant also sells display monitors to original equipment manufacturers (OEMs), he stated that these are primarily unbranded units. Nonetheless, the same instruction and warranty manuals accompany both the ORION and unbranded display monitors, and include the ORION trademark thereon.

Both opposer and applicant have attended at least some of the same trade shows, e.g., the Comdex 2000 show. Applicant was aware of opposer's ORION products and its sales in the U.S. at the time it chose its ORION trademark.

Both TVs and computer display monitors contain CRTs (unless a different technology is used), although a display monitor CRT has a higher resolution than a TV CRT, and a TV CRT has a bigger dot pitch than a computer display monitor CRT. Generally, a TV has a tuner, which enables the TV to show TV programming. A TV attached to a VCR or DVD player can show movies. Similarly, a computer display monitor attached to a computer hard drive with a graphics card and a DVD player can show movies. Additionally, with a TV tuner plugged into a computer, one can watch TV programming on a computer display monitor; with WebTV, one can interact with the Internet on a TV, as one would on a display monitor attached to a computer with Internet access; and LCD display monitors can be used to watch TV, with a TV tuner.

As evidenced by opposer's Exhibit No. 24, Best Buy and Circuit City, electronics retailers, sell TVs, VCRs and computer display monitors. And as both parties' witnesses have stated, a number of companies manufacture and sell TVs, VCRs, DVDs and computer display monitors under the same trademarks, for example, Sony, Toshiba, Samsung and Phillips, as well as LG and Daewoo. Additionally, there are several third-party trademark registrations wherein the same mark is registered for computer monitors, TVs and VCRs,

and/or TV monitors.⁸ The December 14, 2001 magazine GQ contains an advertisement for a 15.1 inch Zenith LCD High definition TV that can be used as a computer monitor by merely flipping a switch. Applicant's witness, Mr. I.S. Kim, admitted that applicant manufactures LCD monitors that, with the addition of a TV tuner, can be used to watch TV programming. It is not clear whether applicant's LCD monitor is sold under the ORION brand or in the U.S.

There are numerous use-based third-party registrations for the mark ORION for a wide variety of products (none identical to those involved herein) in International Class 9.⁹ The record also includes excerpts from Internet web sites apparently sponsored by some of these third-party registrants. There are numerous Internet listings for entities that include the term ORION in their name, although the nature of these entities, the trademarks they may use, or their continuing existence cannot be determined from the record.

There have been numerous instances of actual confusion wherein consumers owning a computer display monitor

⁸ Registration No. 1,622,127 for SONY for, inter alia, TVs, video tape recorders and computer monitors; Registration No. 2,286,001 for NEXTV and design for "monitors, namely, digital television monitors, computer monitors, and videophone monitors; and Registration Nos. 2,399,786 and 1,551,738 for ZENITH for, inter alia, TV monitors, and VCRs and computer display screens, respectively.

⁹ Applicant's submission by notice of reliance included many applications which are evidence only that the applications have been filed and, thus, are of little or no probative value.

manufactured by applicant have telephoned or e-mailed opposer for warranty or other customer service assistance.

Analysis

1. Whether Application is Void Ab Initio.

Opposer contends that applicant, at the time it filed the application and amended its identification of goods during examination, was using its mark only on computer monitors; and states the following (Brief, p. 26-27):

The opposed application is invalid because Applicant falsely signed and filed, on February 18, 1999, the original application oath for its application, based solely under Section 1(a) of the Lanham Act, when Applicant knew, or should have known, Applicant was not using the mark within the meaning of the Trademark Act, on all of the goods identified in the application in U.S. interstate commerce.

Applicant contends that it did not commit fraud with respect to the goods recited in its application. Applicant argues that the identification of goods in the application as originally filed was a "misstatement" that was corrected by amendment prior to publication; that the retention of "moniputers" in the identification of goods as published "was an inadvertent, unintentional error as to timing," stating that moniputers bearing the mark were first "introduced" in the U.S. in 2000; and that applicant's personnel do not speak English as their native language and the inclusion of moniputers "was the result of a

misunderstanding in communications, not intentional fraud.”
(Brief, p. 27.)

In order to prevail on a claim of fraud for misstating in an application that the mark is in use on certain goods, opposer must plead and prove that respondent knowingly made "false, material representations of fact in connection with [its] application." *Torres v. Cantine Torresella S.r.L.*, 808 F. 2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). To constitute fraud on the U.S. Patent and Trademark Office, a statement must be (1) false, (2) made knowingly, and (3) a material representation. The charge of fraud upon the Office must be established by clear and convincing evidence. See, *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986).

Clearly, statements regarding the use of the mark on goods are material to issuance of the registration. See, *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988) (fraud found in applicant's filing of application with verified statement that the mark was in use on a range of personal care products when applicant knew it was in use only on shampoo and hair setting lotion). See also, *General Car and Truck Leasing Systems Inc. v. General Rent-A-Car Inc.* 17 USPQ2d 1398 (D.C. S.Fla. 1990), *aff'g General Rent-A-Car Inc. v. General Leaseways, Inc.*, Canc. No. 14,870 (TTAB May 2, 1998); *Joseph Avakoff v. Southern*

Pacific Co. & Southern Pacific Transportation Co., 765 F.2d 1097, 226 USPQ 435 (Fed. Cir. 1985); and *McCarthy on Trademarks and Unfair Competition*, 4th ed. 2003, J. Thomas McCarthy, §31.73 and cases cited therein.

The recent case of *Medinol Ltd. V. Neuro Vasx, Inc.*, 67 USPQ2d 1205 (TTAB 2003) (fraud found in statement of use where no use of mark on one of two listed goods) is analogous to this case. In that case, a trademark application was filed, the mark was published, a statement of use filed, and registration issued for goods identified as "medical devices, namely, neurological stents and catheters"; however, applicant admitted that the mark was not used on stents, and offered, in an unconsented motion, to delete "stents" from its identification of goods. The Board stated the following (at 1208):

The fraud alleged by petitioner is that respondent knowingly made a material representation to the USPTO in order to obtain registration of its trademark for the identified goods. There is no question that the statement of use would not have been accepted nor would registration have issued but for respondent's misrepresentation, since the USPTO will not issue a registration covering goods upon which the mark has not been used. (*cites omitted.*)

...

Most importantly, however, deletion of the goods upon which the mark has not yet been used does not remedy an alleged fraud upon the Office. If fraud can be shown in the procurement of a registration, the entire resulting registration is void. *General Car and Truck Leasing Systems, Inc. v. General Rent-A-Car Inc.*, [*supra*]. Allowing respondent's amendment would be beside the point; even if "stents" were deleted from the

registration, the question remains whether or not respondent committed fraud upon the Office in the procurement of its registration.

Applicant in the case before us argues that its error was inadvertent, due to language difficulties and miscommunication. Respondent in *Medinol Ltd. V. Neuro Vasx, Inc.*, *supra*, similarly indicated its lack of intent to commit fraud; and the Board stated the following (at 1209):

The appropriate inquiry is therefore not into the registrant's subjective intent, but rather into the objective manifestations of that intent. "We recognize that it is difficult, if not impossible, to prove what occurs in a person's mind, and that intent must often be inferred from the circumstances and related statement made by that person." *First International Services Corp. v. Chuckles Inc.*, [*supra* at 1636]. See, *Torres*, [*supra*] at 1484-85; *General Car and Truck*, [*supra*] at 1400; ... *Western Farmers Ass'n v. Loblaw Inc.*, 180 USPQ 345, 347 (TTAB 1973).

In *Medinol*, the Board concluded that the facts warranted a finding of fraud (at 1209-1210):

The undisputed facts in this case clearly establish that respondent knew or should have known at the time it submitted its statement of use that the mark was not in use on all of the goods. Neither the identification of goods nor the statement of use itself were lengthy, highly technical, or otherwise confusing, and the President/CEO who signed the document was clearly in a position to know (or to inquire) as to the truth of the statements therein.

In the case before us, applicant admits that it has used the ORION mark only on computer display monitors; that the additional goods were included in the application, according to Mr. I.S. Kim, because applicant considered the

possibility of using the mark in connection therewith; but that applicant has no intention of manufacturing and selling such goods under the ORION mark in the U.S. These facts clearly establish that applicant knew or should have known at the time it submitted its application, and later when it amended its identification of goods by deleting numerous items, that the mark was not in use on all of the goods listed upon publication,¹⁰ and, thus, that its sworn statement in the application was materially incorrect. We note that, by specifically adding "moniputers" to the identification of goods as part of the amendment deleting other goods, applicant must be presumed to have known what it was doing. This is not a case where applicant realized its mistake and deleted a number of items upon which the mark had not been used, while inadvertently failing to also delete "moniputers."

We conclude that applicant's material misrepresentations made in its application in connection with the goods upon which its mark is used were fraudulent. Therefore, the application, in its entirety, is void ab initio.

¹⁰ Citing *Universal Overall Co. v. Stonecutter Mills Corp.*, 379 F.2d 983, 154 USPQ 104 (CCPA 1967), applicant correctly notes that "a misstatement in an application as to which goods a mark has been used does not rise to the level of fraud where an applicant amends the application prior to publication. (Brief p. 26.) In determining the question of fraud in the case before us, we have not considered the goods deleted by applicant prior to publication. Our only reference is the goods identified in the application as published.

*3. Applicant's Unconsented Motion to Amend
Identification of Goods.*

Applicant stated that it "is willing to amend its application to delete 'moniputers' from the description of goods [and that] [a]pplicant has notified the U.S. Patent and Trademark Office of its desire to so amend the description of good[s]." (Brief, p. 28.) The record contains no such notification. In view of the above finding of fraud, we find applicant's motion without consent (i.e., the aforementioned Examiner's Amendment) to amend the identification of goods to "display monitors, moniputers, and computer peripherals," is moot.

However, had we considered the substance of applicant's motion to amend the identification of goods to include moniputers and computer peripherals, we would deny the motion because applicant has not used the mark in connection with such goods as of the application filing date.

Nonetheless, should applicant ultimately prevail on appeal on the issue of fraud, the identification of goods as published must be restricted to "display monitors," thereby deleting "moniputers and related accessories," because applicant may not register its mark under Section 1(a) of the Trademark Act for goods upon which it has not used the mark.

3. *Likelihood of Confusion.*

Although our determination that the errors in the identification of goods constitute fraud is sufficient to sustain the opposition, in the interest of rendering a complete decision, we turn to the issue of likelihood of confusion pleaded by opposer.

Inasmuch as a certified copy of opposer's registration is of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Opposer contends that its mark is a very strong mark with significant good will in the consumer visual electronics industry; that the parties' marks are identical; that "both parties' goods are consumer visual electronics products housed in cube shaped cabinets with identical ORION marks affixed in identical locations" (Brief, p. 16); that applicant's goods are highly related to those of opposer, "share identical uses and functions" to those of opposer (Brief p. 18), and are within opposer's logical zone of expansion; and that the goods travel through the identical trade channels to the same class of purchasers. Additionally, opposer alleges considerable actual confusion in the form of misdirected e-mails and telephone calls to opposer regarding applicant's computer monitors.

Applicant concedes that the parties' marks are identical in spelling, sound and connotation, but contends that the visual appearance differs due to the stylized manner in which applicant uses its mark. Further, applicant argues that it owns prior Registration No. 1,114,405 for the identical mark and the USPTO allowed the registration of opposer's pleaded mark; that, regardless of applicant's prior registration, opposer chose to use and register the identical mark; and that, in view of applicant's prior registration, the identity of the parties' marks in this case should not weigh in opposer's favor.

Regarding the goods, applicant disagrees that the goods are related or share identical uses or functions. Applicant states the following (Brief, p. 10):

A monitor is a peripheral device intended to be connected to a computer. A television is a stand alone product primarily intended to broadcast television programming. Computers run software and are primarily used for word processing and computing. Monitors do not have remote control features, lack channels, and do not receive cable signals. The cathode ray tubes used in monitors and television sets are not compatible. Nor are televisions used to run software, do word processing, or perform computations.

Applicant disputes opposer's statement that both products may be used for surfing the Internet and watching television, stating that each must first be connected to another device to perform both functions; and, further, both uses are not the primary purpose of either product.

Applicant states that "the primary function of a monitor is to enable one to use a computer ... [whereas] the primary function of a television set is to enable one to watch television by receiving broadcasts or cable television or to watch videotapes or DVD's through an attached player."

(Brief, p. 12.) Applicant disagrees that business expansion from producing televisions to computer monitors is natural or likely to cause confusion; and questions the likelihood of opposer actually expanding its business in such a direction.

Applicant contends that the trade channels for the respective goods are different and that the goods are expensive and, thus, purchased with care by knowledgeable consumers. Applicant contends that ORION is a weak mark, that there is extensive third-party use, and that opposer has not established that its mark is well known. Finally, applicant argues that opposer's evidence of actual confusion is weak anecdotal evidence that constitutes hearsay, and the parties' marks and goods have coexisted in the U.S. market for four years with no actual confusion.

Considering, first, the marks of the parties, there is no question that the marks herein are identical, which applicant admitted in its answer. The marks, both of which are in typed form, are identical in appearance, sound, connotation and commercial impression.¹¹ We are not persuaded otherwise by applicant's allegation that it possesses a registration for the mark ORION. We note that the registration is for different goods, namely, "cathode ray tubes (black and white and color) and parts and accessories thereof, electron guns (black and white and color) and parts and accessories thereof, photo tubes and electric discharge tubes," none of which are finished products as are computer display monitors, TVs and VCRs;

¹¹ Applicant's allegation regarding the manner in which its mark appears on its products is not persuasive. We must consider the fact that the application contains a typed drawing and, thus, encompasses any number of design possibilities.

and, further, we must decide this case based on the facts in the record before us.

Applicant contends that ORION is a weak mark and submitted in support thereof several lists of businesses from various sources that include ORION in their names; a number of third-party use-based registrations for marks that include ORION for a wide variety of International Class 9 goods; and excerpts from Internet websites allegedly owned by a few of the third-party registrants. This evidence is of limited value because it does not establish third-party use of ORION as a trade name or trademark in connection with goods related to those involved in this case.

Similarly, opposer's evidence that its mark is well known is of limited value. Opposer primarily sells its products through Wal-Mart, a mass merchandiser who presumably sells a large number of many products. It is unclear from the record whether opposer's sales volume is due to brand recognition or positioning of sales at Wal-Mart stores. Therefore, we find that, while ORION is arbitrary in connection with the parties' goods, it is not necessarily a strong or well known mark.

It is well established that when the marks at issue are the same or nearly so, the goods in question do not have to be identical to find that confusion is likely. As we stated in *In re Concordia International Forwarding Corp.*, 222 USPQ

352, 356 (TTAB 1983), "... the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion." It is sufficient that the goods are related in some manner and that their character or the circumstances surrounding their marketing are such that they are likely to be encountered by the same people in situations that would give rise to the mistaken belief that the producer was the same. *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

With respect to the goods of the parties, applicant correctly points out that TVs and computer display monitors are not the same and no one is likely to mistake a computer display monitor for a TV or vice versa. A TV by definition includes a tuner, either externally or internally, so that it can show television programming. A computer display monitor has no built in hard drive, tuner, or other device; rather, the monitor is attached to a computer so that information from the computer can be visually displayed via the monitor. However, the evidence establishes that there is some crossover in the use of these goods and that the technological trends appear to be moving to more, rather than less, crossover use. For example, the record establishes that computers now often include DVD players,

allowing users to watch movies via their computer as displayed on the monitor. Both DVD players and VCRs can be attached to TVs for viewing movies on a TV screen. Similarly, the evidence establishes that both TVs and computers, with monitors, can be used to access the Internet and send and receive e-mail. Additionally, the evidence establishes that both TVs and computer display monitors are often produced using LCD technology and, thus, these products may be interchangeable. Significantly, the record clearly establishes that a number of large electronics manufacturers make, and identify by the same trademark, TVs, VCRs and computer display monitors. Thus, we conclude that the goods of the parties are closely related.

Further, both opposer's and applicant's identifications of goods are broadly worded, without any limitations as to channels of trade or classes of purchasers. We must presume that the goods of the applicant and opposer are sold in all of the normal channels of trade to all of the usual purchasers for goods and services of the type identified. *See, Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In other words, we conclude that the channels of trade and class of purchasers of the parties' goods are the same. We acknowledge that applicant manufactures computer display monitors and does not sell them directly to the ultimate consumer. However, whether

bundled with other computer products or sold separately, applicant's goods identified by the ORION mark do make their way through retail sales to the ultimate consumer, who is the same general purchaser of TVs and VCRs.¹²

Opposer has submitted significant and specific evidence, previously outlined, that purchasers of applicant's computer display monitors have been confused as to the source of those goods and numerous individuals have contacted opposer's consumer services representatives seeking warranty or other assistance.¹³ As stated herein, we do not find this evidence to be hearsay; rather it is strong evidence that actual confusion exists in the marketplace.

Therefore, in view of the fact that the marks herein are identical, the channels of trade and purchasers are overlapping, if not the same, and actual confusion has occurred, we conclude that the contemporaneous use of the marks on the closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of

¹² We are not persuaded that the consumers of the goods involved herein are all sophisticated and knowledgeable purchasers of computer monitors, TVs and VCRs. Applicant has given us no evidence establishing this fact and, similarly, the evidence indicates that these products can range in price, with a relatively inexpensive low end. We must assume from the evidence that the purchasers of the parties' respective goods include all consumers of such products.

¹³ Applicant's witnesses questioned whether the inquiries pertained to their computer monitors, noting that some of the product identification numbers were for applicant's unbranded, rather than its ORION, monitors. We find these statements disingenuous because applicant's witnesses admitted that the same instruction and warranty manuals, containing the ORION mark, accompany both branded and unbranded monitors.

such goods. We are not persuaded otherwise by applicant's evidence that ORION is a weak mark. Not only are none of the other marks or businesses that are actually identified as being in use or registered for products as closely related to opposer's products as are applicant's goods, but even weak marks are entitled to protection.

Decision: The opposition is sustained on both the grounds of fraud and likelihood of confusion.